

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Crocker et al.

Title: METHODS FOR ADDITIVE
REPAIR OF PHASE SHIFT
MASKS BY SELECTIVELY
DEPOSITING NANOMETER-
SCALE ENGINEERED
STRUCTURES ON
DEFECTIVE PHASE SHIFTERS

Appl. No.: 10/689,547

Filing Date: 10/21/2003

Examiner: Ruggles, John S.

Art Unit: 1795

Confirmation 9313
Number:

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) determined for the captioned application, for which the notice of allowance was mailed on August 28, 2009.

The Patent Office determined that the patent was entitled to 25 days of PTA. Applicants believe that this PTA determination was made in accordance with the “Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)” published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of "overlap" are limited to "periods of time . . . [that] occur on the same day." *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." *Id.*

Applicants have recalculated PTA for the captioned application under the court's interpretation of the PTA statute, and have determined that the application is entitled to 428 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B): 804 days

(b) Total Applicant delay: 376 days

Final PTA Determination: 428 days

Applicants therefore respectfully request that the forthcoming granted patent be accorded 428 days PTA.

Payment of the requisite fee is submitted herewith. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Applicants request further that a decision on this request be **deferred or delayed** until a final decision has been rendered in *Wyeth v. Dudas*, which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120.

Respectfully submitted,

Date November 24, 2009

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Patent Term Adjustment Calculation System

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Docket Number: 083847-0198

Application Number: 10/689547

Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Application Filing Date	10/21/2003	0		
Edit Delete	IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO	07/21/2004	274		
Edit Delete	IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO	10/13/2004	358		
Edit Delete	IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO	10/25/2004	370		
	14 month From Application date	12/21/2004	427		
Edit Delete	Restriction Requirement	01/26/2006	828	401	
Edit Delete	Restriction Requirement Response Received at PTO	02/27/2006	860		
Edit Delete	IDS under 1.704(c)(8) filed at PTO	03/16/2006	877		17
Edit Delete	Non-Final Office Action	06/08/2006	961		
	Non-Final Office Action + 3 months	09/08/2006	1,053		
	3 Year Period Starts	10/21/2006	1,096		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	11/08/2006	1,114		
Edit Delete	Notice of Non-Compliance	12/04/2006	1,140		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	12/08/2006	1,144		(91),(30) 91
Edit Delete	Final Office Action	01/19/2007	1,186		
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Edit Delete	Final Office Action Response Received at PTO	06/04/2007	1,322		
Edit Delete	Advisory Action	06/07/2007	1,325		
Edit Delete	Request For Continued Examination (including amendment)	07/16/2007	1,364	288	88
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	Non-Final Office Action + 3 months	01/04/2008	1,536		
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	Final Office Action + 3 months	09/16/2008	1,792		

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	Pre-Appeal Brief Request + 4 Months	04/15/2009	2,003	
Edit Delete	Request For Continued Examination (including amendment)	07/14/2009	2,093	
Edit Delete	Notice of Allowance	08/28/2009	2,138	135
	Projected Patent Grant Date	03/09/2010	2,331	
			Totals:	804
			PTA:	376
				428

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IP: 10.14.53.36

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